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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/626,418      | 07/26/2000  | Eric C. Anderson     | P206/1847P          | 8121             |

49278 7590 06/27/2005

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| EXAMINER |
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TRAN, NHAN T

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| ART UNIT | PAPER NUMBER |
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2615

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                                 |  |
|------------------------------|-------------------------------|---------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>09/626,418 | Applicant(s)<br>ANDERSON ET AL. |  |
|                              | Examiner<br>Nhan T. Tran      | Art Unit<br>2615                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-18 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-18 and 20-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1, 12 & 23 have been considered but are moot in view of the new ground of rejection.

Additionally, upon further consideration, claims 2-7, 9-11, 13-18 and 20-22 are withdrawn from allowable subject matter.

### ***Claim Objections***

2. Claims 1, 12 & 23 are objected to because the claims recite "the image capture device" which is suggested to change to --the hand-held image capture device-- for fully supported by antecedent basis of a hand-held image capture device. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7, 9-18 & 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chui et al (US 6,657,702) in view of Kojima et al (US 2004/0174440 A1).

Regarding claim 1, Chui discloses a method for allowing a user to select actions (printing, e-mailing, etc., see Figs. 5-7C) to be taken by a server (300, Fig. 3A) when uploading images from a hand-held image capture device (digital camera 108, Fig. 1) over a network, the method comprising the steps of:

(a) downloading (by loading a webpage using a web browser) an action list (Figs. 5-7C) from the server to the image capture device after the image capture device (this equates to a combined apparatus of the digital camera 108 and computer 100) establishes a connection with the server, the action list (i.e., a list of actions under "Picture Delivery") including one or more items representing actions that the server should take with respect to uploaded images (see col. 1, lines 40-42; col. 10, lines 40-65 and col. 15, line – col. 17, line 6);

(b) displaying the action list to the user on the image capture device after the user initiates an image upload process (see Figs. 5-7C);

(c) after the user selects at least one of the items in the action list, sending the images and the selected action list item from the image capture device to the server (i.e., a server printer 340); and

(d) performing the action (i.e., printing) on the uploaded images specified by the selected action item. See col. 15, line – col. 17, line 6.

Chui does not teach that the image capture device and a hand-held image capture device are a single device. However, as taught by Kojima, a hand-held image capture device comprises both a digital camera (23) and a computer (see Fig. 1, paragraphs [0021] & [0022]), wherein the hand-held image capture device is operated under OS windows 98 which is inherently includes a

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web browser such as an internet explorer for internet access via modem 50 (see Fig. 7 and paragraph [0032]).

Therefore it would have been obvious to one of ordinary skill in the art to combine the teachings of Chui and Kojima to implement a hand-held image capture device having all features and functions equivalent to the combined digital camera and computer in Chui so as to offer users a convenient and highly operable hand-held image capture device for capturing images and ordering online services.

*(note that the Examiner reserves the right to address features from Prior Art shown in Figs. 1-2F in Chui if necessary).*

Regarding claim 2, it is clear that the server is a part of photo-sharing service website (see Chui, Figs. 5-7C).

Regarding claim 3, also disclosed by Chui is that the action list includes at least of one a print item, a store item that instructs the server where to store the images, a send item that instructs the server where to send the images (see Figs. 5-7C; col. 18, line 48 – col. 20, line 25).

Regarding claim 4, Chui also discloses a step of providing the store item instructs the server to store the images within the photo-sharing service website (col. 15, line 59 – col. 16, line 9).

Regarding claim 5, Chui further discloses the step of providing that the store item instructs the server to store the images to a location external to the photo-sharing website (see Figs. 7A & 7B, wherein the images are sent to an external in-box via e-mail or the images are simply printed and sent to a physical address where the images are stored).

Regarding claim 6, Chui further discloses a step of providing e-mail address as the send item in the action list (see Fig. 7A).

Regarding claim 7, Chui further discloses that the user can create the action list on the image capture device (col. 16, lines 22-36).

Regarding claim 9, Chui also discloses steps of creating a user account for the user the first time the image capture device establishes a connection with the server, and creating a default action list for the user (col. 22, lines 16-24, wherein “the first time the image capture device establishes a connection with the server” is encompassed).

Regarding claim 10, it is clear in Chui that the method includes the step of allowing the user to manually create the action list on the photo-sharing service website by navigating to the photo-sharing service website using a web browser and manually creating the action list (see col. 16, lines 22-36).

Regarding claim 11, Chui also discloses automatically creating the action list on the photo-sharing service website in response to the user actions performed on the photo-sharing service website through a web browser (see Chui, col. 16, lines 22-36 and col. 22, lines 10-23, wherein if the user does not need to re-arrange or modify the action list, a default list is automatically created).

Regarding claims 12-18, see the analyses of claims 1-7, respectively.

Regarding claims 20-22, see the analyses of claims 9-11, respectively.

Regarding claim 23, see the analysis of claim 1, wherein “storing an action list on the image capture device” is inherent since the action list must be loaded into a buffer of the image capture device in order for the web browser to operate as disclosed. Furthermore, the action list includes any combination of specifying a storage location, sending the images to one or more email addresses and analyzing or performing calculations on the image (for printing) is also disclosed in Figs. 5-7C as analyzed in claims 3-6.

### ***Conclusion***


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhan T. Tran whose telephone number is (571) 272-7371. The examiner can normally be reached on Monday - Thursday, 8:00am - 6:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NT.



DAVID L. OMETZ  
PRIMARY EXAMINER